

REMARKS

The Examiner is requiring restriction to one of the groups as recited on pages 2-5 of the Official Action and with the further requirement for the election of a single disclosed species as set forth in the Office Action of November 23, 2005

Applicants provisionally elect group I (claims 147-190, 201-207, 221-245 and 264-267) with traverse and further elect the single compound 4-chloro-2-(morpholin-4-yl-o-tolylmethyl)-naphthalin1-ol (corresponding to example 18) also with traverse. All of the claims read on the elected species.

Unity of invention indeed exists between groups I-XI, there is a technical relationship that involves the same special technical feature that defines the contribution which each of the groups taken as a whole, makes over the prior art.

The Office has failed to follow MPEP guidelines for making lack of unity of invention requirement between restricted Groups M.P.E.P. 1893.03(d) states:

“When making a lack of unity of invention requirement, the Examiner must (1) list different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no simple general inventive concept) a specifically describing the unique special technical feature in each group.”  
The Examiner has not sufficiently explained why each group lacks unity with each

other and has not specifically described the unique special technical feature in each group to justify the conclusion of lack of unity of invention. The Office merely states that the various substituent groups have many variables and have achieved a different status in the art and are burdensome to search.

The Office fails to consider that there is indeed a common significant structural element that is shared by all: preparation of medicament for treating diseases. Applicant respectfully point out the Administrative Instructions in MPEP, Annex B, Part 2 which gives clear guidance on situations regarding Markush practice in the PCT such as the present.

The Office is also respectfully reminded that search burden has absolutely no force in restricting PCT cases as the present. See e.g., M.P.E.P. Annex B, Part 1 (f)(iv): "The fact that the alternatives of a Markush grouping can be differently classified shall not, taken alone, be considered to be justification for the finding of lack of unity of inventions." Indeed, the Office has not even established a prima facie search burden. Rather, that Office merely alleged, without support, that the claims are burdensome to search.

M.P.E.P. 803 states:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact the International Search Authority has searched the claims together. The Office has not advanced any compelling evidence or arguments to show why restrictions should be required when the International Preliminary Examination Report, already of record, did not find the application to lack unity of invention.

Applicants have provided the Office with an election of species. Applicants respectfully submit that the election of species is made for search purposes only, and the Office has not established any basis for restricting between the elected species.

Every member of the Markush group need not be supported by a specific example directed thereto, Ex parte D'Alelio (POBA 1962) 137 USPQ603, each member is specifically contemplated in the specification and the Markush group is supported by a generic teaching and examples show how to prepare those members whose preparation is not specifically disclosed; Ex parte Druey et al (POBA 1964) 145 USPQ 219, and how to use them.

All of the possible substituents of a Markush class of compounds need not be illustrated by specific compounds bearing them if the claims thereto are otherwise reasonably commensurate in scope with the disclosure i.e. all members of the Markush group are

specifically contemplated by the generic disclosure and there is no reason advanced why all of the compounds of the claimed genies will not have the properties ascribed to them.

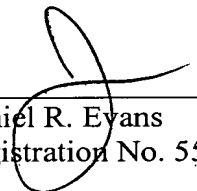
Applicants request that should the elected species is found to be allowable, the Examiner expand his search to include non-elected species.

Divisional applications filed thereafter claiming the non-elected invention should not be subject to a double patenting ground of rejection. 35 USC 121, In re Joyce (Comr Pats 1957) USPQ 412.

If the invention of Group I is found to be allowable, withdrawn claims which depend from or otherwise include all the limitations of the allowable claims shall be rejoined. MPEP 821.04 Applicants submit that the above identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

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